

## REMARKS/ARGUMENT

### Description of Amendments

Claims 1, 4, 6, 8, 9, 11-13, 20, 22, 23 and 28 were amended and Claims 29-31 added. No new matter was added. As amended, Claims 1-14 and 17-31 remain pending for consideration and Claims 15 and 16 are withdrawn.

The amendments to Claim 1 and new Claims 29-31 are supported by the application as originally filed. See, e.g., page 8, lines 11-14 and Figs. 3-4.

### Rejection under 35 U.S.C. §112, second paragraph

Claims 9, 20, 23, and 28 were amended to address the rejections as set forth on page 2 of the Official Action. These claims comply with all requirements of Section 112. Withdrawal of the rejections under Section 112 is earnestly solicited.

### Rejections under 35 U.S.C. §103(a)

Claims 1-14 and 17-28 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Jacob* (U.S. Patent 5,087,418) or *Usui* (U.S. Patent 5,591,268) in view of *Sirhan* (WO 03/037223). For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejections.

As previously set forth in Applicant's April 25, 2007, response, independent Claims 1 and 24 recite an apparatus to plasma coat a stent and independent Claim 10 recites an apparatus to coat an implantable medical device, which apparatus includes a source that supplies a polymerizable monomer gas and an energy source. In contrast, *Jacob* is directed to a process for dry sterilization of medical devices and *Usui* is directed to a process for manufacturing semiconductor wafers. Neither of these references teach or suggest plasma coating a stent or an implantable medical device. However, the Official Action has concluded that Claims 1, 10 and 24 would have been obvious over *Jacob* and/or *Usui*, in combination with the stent coating processes disclosed in *Sirhan*.

In reply to Applicant's April 25, 2007 response and in the rejection that follows, the Official Action states that it would have been obvious, in view of *Sirhan*, to use a plasma

chamber taught by *Usui* and *Jacob*, as modified to receive a stent and mandrel within the chamber. As best understood, the Official Action has concluded that *Sirhan*'s suggestion for using a plasma chamber for stent coating would have lead one of ordinary skill in the art to choose the apparatuses described in *Usui* and *Jacob*. Applicant traverses this rejection for the following reason.

There is no description in *Sirhan* for the manner in which the stent is mounted or supported within a plasma chamber, whether a mandrel or other type of supporting device is used for plasma coating, or how the elements of the chamber are configured in the plasma chamber. In short, *Sirhan* provides no teaching for using one type of plasma chamber over another. Nor is there any description in *Jacob* or *Usui* that would have suggested that these apparatuses are better suited for plasma coating a stent than another type of plasma deposition/glow discharge chamber known at the time of the invention.

There must be some rationale set forth as to why one of ordinary skill in the art would have been motivated to use the particular configuration of a plasma chamber described in *Usui* or *Jacob* for stent coating before a rejection can be properly made under 35 U.S.C. § 103(a). *See* MPEP 2143.01. None of the cited prior art provides a basis for concluding that one of ordinary skill in the art would have chosen the particular arrangement in *Usui* or *Jacob*. Moreover, neither the current nor prior Official Actions have attempted to provide a reason for why one of ordinary skill would have been so motivated given the absence of a teaching, suggestion or motivation in the prior art of record. Instead, the rejection appears to rely only on the conclusion that one of ordinary skill in the art would have been motivated to use any apparatus that could be modified to coat a stent, provided it falls within the broad category of plasma deposition/glow discharge chambers referred to in *Sirhan*. However, this type of reasoning is not legally sufficient to establish a motivation to combine. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination". *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); *see also* MPEP § 2143.01. Accordingly, Applicant respectfully submit that because there was no motivation for using the specific apparatus described in *Usui* or *Jacob*, a *prima facie* case of obviousness has not been made. For this reason, Applicant respectfully asks that the rejection of Claims 1, 10 and 24 under 35 U.S.C. § 103(a) be withdrawn and these claims allowed.

Even assuming that one of ordinary skill in the art would have been motivated to use the apparatus of *Usui* or *Jacob* for plasma coating a stent supported on a mandrel, there would have been no motivation for supporting the mandrel as a cantilever from the first plasma member as set forth in Claim 1. Both *Usui* and *Jacob* disclose a basket for supporting material within the plasma chamber. The basket is either placed on non-conducting rails, *see Usui* at col. 6, ll. 50-53, or fixed at its ends, *see Jacob* at col. 9, ll. 45-48. In either case, the basket is not supported in the chamber as a cantilever. Thus, even assuming that one of ordinary skill in the art would have been motivated to use the *Usui* or *Jacob* device for plasma coating a stent, the mandrel would have been supported at its ends in light of the teaching of this art, not as a cantilever from a first plasma member. For this additional reason, Applicant respectfully asks that the rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn and this claim allowed.

On pages 5 and 8, the Official Action states that the phrase “to coat a stent” and “implantable medical device”, respectively, are intended use limitations that the apparatus of the prior art is capable of performing because the prior art meets the structural limitations of the claims. However, for the reasons just stated, the prior art does not teach each of the structural limitations of Claims 1, 10 or 24 because there was no teaching or suggestion for combining the references. Accordingly, Claims 1, 10 and 24 are patentable over the prior art.

Claims 2-9, 11-14, 16-23 and 25-28 depend from and therefore include all of the limitations of allowable Claims 1, 10 and 24. As Claims 2-9, 11-14, 16-23 and 25-28 depend from allowable claims, they are also allowable at least for this reason.

#### Patentability of New Claims

New dependent claims 29-31 are also patentable, at least because they depend from patentable independent claims.

Application No. 10/672,890  
Amendment dated September 12, 2007  
Reply to Office action of July 13, 2007

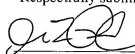
Conclusion

In light of the foregoing remarks, this application is considered to be in condition for allowance. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Respectfully submitted,

Date: September 12, 2007

\_\_\_\_\_  
Squire, Sanders & Dempsey L.L.P.  
One Maritime Plaza  
Suite 300  
San Francisco, CA 94111  
Telephone (415) 954-0241  
[szhu@ssd.com](mailto:szhu@ssd.com)



\_\_\_\_\_  
James L. Reed  
Attorney for Applicant  
Reg. No. 43,877